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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,849	04/12/2004	Russell A. Firestone III	36707-502	1735

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MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C
ATTN: PATENT INTAKE CUSTOMER NO. 64046
ONE FINANCIAL CENTER
BOSTON, MA 02111

EXAMINER

BROOKS, MATTHEW L

ART UNIT	PAPER NUMBER
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3629

MAIL DATE	DELIVERY MODE
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09/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/821,849	Applicant(s) FIRESTONE, RUSSELL A.	
	Examiner Matthew L. Brooks	Art Unit 3629	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

/John G. Weiss/

Supervisory Patent Examiner, Art Unit 3629 DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant made a preliminary amendment and added claim 25 with the limitation "fabricating new sharps containers from the recycled sharps containers". Examiner has done a cursory search of the specification and has been unable to find support.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 3629

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Patent No.: 7,035,856 (Morimoto).

5. Morimoto teaches

A method and system for tracking containers comprising:

a first container, the container having a wireless tracking device attached thereto (Fig. 1A, 40A); and

a tracking station capable of monitoring the movement of the container by tracking the wireless tracking device (Fig 2 and 3).

And monitoring the movement of a first container having a wireless tracking device attached thereto from one point to another second point using the wireless tracking device (C1, 5-12). And all other features normally provided by a tracking system such as hand held reader (C3, 10); satellite or cellular station (Fig 3); use of a computer (Fig 2, 90); weighing capabilities (C2, 65-67); and wherein the wireless tracking operates at radio frequencies (C3, 2).

Morimoto does not discuss that medical waste was in the containers and containers adapted to hold treated medical waste and other such steps that are common to one of ordinary skill in the art of waste treatment such as segregating waste by type and charging for its proper disposal as claimed. However it does teach that the containers can be specialized (C2, 7-10). In determining the obviousness of applying

what is generally known in the shipping industry to what is known in the world of waste disposal one must determine the level of ordinary skill (*Dann v. Johnston*, 425 U.S. 219, 189 USPQ 257 (1976)). The medical waste management industry, to one of ordinary skill in the art, for sometime now hospitals have placed waste in proper containers for disposal, separated into different but like categories and been charged for its proper disposal. Also the shipping/delivery industry has utilized radio frequency tracking and specialized containers for years to transport goods no matter what they may be.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the shipping system of Morimoto in a typical waste disposal system such as that in any hospital for the purpose of keeping track of waste disposed of. The desirability to do this is clearly to keep track of the deliverables/waste.

Also it should be noted as to the system claims Morimoto teaches nearly the identical system but does not teach the specific goods/waste shipped and recited in the claimed invention. However, the specific goods shipped in the containers does not patentably distinguish the claimed system. Further, the recited statement of intended use, does not patentably distinguish the claimed system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the system of shipping for any type of goods in the system taught by Reference Morimoto because the goods shipped does not patentably distinguish the claimed invention; a network system.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. 6321983; 5,628,412; 5423431; 5100005.

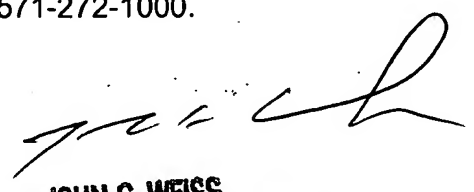
Also see The MIT Press Journals – Journal of Industrial Ecology; Vol. 6, Issue 2 – E-commerce, the Internet, and the Environment; A special issue of the JIE guest edited by David Reheski, Foresight and Governance Project Director, Woodrow Wilson International Center for Scholars, Washington, DC. (attached)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (571) 272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-8112. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MLB
3/10/08



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